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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/747,773

Applicant(s)

ARNOFF ET AL.

Examiner

Gerald Gauthier

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 21-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) 15 is/are allowed.
6) ☒ Claim(s) 21-39 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. **Claim(s) 34** is objected to because of the following informalities: in line 9, "is s subscriber" should be "is a subscriber". Correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 2614

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim(s) 21-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Skladman et al. (US 6,487,278 B1) in view of Pepe et al. (US 5,742,905).

Regarding **claim(s) 21**, Skladman discloses a system for accessing messages sent from a caller for a callee (FIG. 1a-b and column 1, lines 21-24), the system comprising:

an analog voicemail system configured to store a received analog voicemail message (50 on FIG. 1a);

a digital voicemail system (64 on FIG. 1a) configured to store a received digital voicemail message, the digital voicemail system including means for converting the received digital voicemail message into an analog voicemail message, wherein the converted analog message is configured for storage at the analog voicemail system (column 6, lines 21-34); and

a messaging server (34 on FIG. 1b) coupled to the standard telephone system (62 on FIG. 1a), the messaging server further being coupled to the analog voicemail system, the messaging server further being coupled to the digital voicemail system (column 4, lines 9-20), the messaging server comprising:

means for extracting the received analog voicemail message from the analog voicemail system (column 4, lines 54-64);

means for digitizing the extracted analog voicemail message (column 5, lines 7-10); and

means for sending the digitized voicemail message to the digital voicemail system (column 4, lines 11-17).

Skladman fails to disclose create a temporary digital mailbox for storing a received digital voicemail message.

However, Pepe teaches create a temporary digital mailbox for storing a received digital voicemail message (column 33, lines 11-16).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Skladman using the teaching of digital voicemail system as taught by Pepe.

This modification of the invention enables the system to create a temporary digital mailbox for storing a received digital voicemail message so that the user would have the digital message over the wireless terminal.

Regarding **claim(s) 22**, Skladman discloses a system, wherein the digital voicemail system is further configured to send a query regarding whether the callee is a subscriber of the analog voicemail system.

Regarding **claim(s) 23**, Skladman discloses a system, wherein the digital voicemail system is further configured to, in response to an indication that the callee is a

subscriber of the analog voicemail system, convey the converted analog message to the analog voicemail system.

Regarding **claim(s) 24**, Skladman discloses a system, wherein the digital voicemail system is further configured to receive a query for new digital voice messages.

Regarding **claim(s) 25**, Skladman discloses a system of, wherein the query is received via the Internet.

Regarding **claim(s) 26**, Skladman discloses a system, wherein the system is coupled to an Internet call waiting system.

6. Claim(s) 27-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe.

Regarding **claim(s) 27 and 34**, Pepe discloses a digital voicemail system for receiving voicemail from a caller for a callee (FIG. 1 and column 1, lines 8-12), the system comprising:

logic configured to receive a digital voicemail from a caller, the digital voicemail being configured for delivery to a callee (column 28, lines 24-26);

logic configured to, in response to receiving the digital voicemail, send a query for determining whether the callee is a subscriber of an analog voicemail system (column 28, lines 28-30);

logic configured to receive an indication as to whether the callee is a subscriber of an analog voicemail system (column 28, lines 28-30);

logic configured to, in response to receiving an indication that the callee is a subscriber of an analog voicemail system, convert a received digital voicemail message into an analog voicemail message (column 28, lines 30-32); and

logic configured to convey the converted analog voicemail message to the analog voicemail system (column 28, lines 33-35).

Pepe fails to disclose the digital voicemail message converted to analog voicemail message.

It would have been obvious to the one skill in the art to understand by sending the digital voice mail message to an analog voicemail system the voicemail message is converted from digital to analog.

Regarding **claim(s) 28 and 35**, Pepe discloses a system, further comprising logic configured to store the received digital message (column 28, lines 24-32).

Regarding **claim(s) 29 and 36**, Pepe discloses a system, further comprising logic configured to receive a converted digital message from the analog voicemail system (column 28, lines 33-40).

Regarding **claim(s) 30 and 37**, Pepe discloses a system, further comprising logic configured to delete the received digital message (column 28, lines 1-14).

Regarding **claim(s) 31 and 38**, Pepe discloses a system, further comprising logic configured to receive a query for new messages (column 27, lines 59-67).

Regarding **claim(s) 32 and 39**, Pepe discloses a system, wherein the digital voicemail system is an Internet-based system (column 26, lines 36-51).

Regarding **claim(s) 33**, Pepe discloses a system, wherein the digital voicemail system includes an instant messaging system (column 26, lines 36-51).

Allowable Subject Matter

7. **Claim(s) 15** is allowed.

Response to Arguments

8. Applicant's arguments with respect to **claim(s) 15 and 21-39** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

Gerald Gauthier
Examiner
Art Unit 2614

GG.
August 8, 2006